

Notice of Allowability

Application No.

10/766,263

Applicant(s)

MEESE ET AL.

Examiner

Art Unit

Zachary C. Tucker

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE 23 August 2005.
2. ☒ The allowed claim(s) is/are 50-63.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/700,094.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 23Aug05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

JAMES O. WILSON

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1000

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The following amendments to the specification are necessary to render the instant application compliant with 37 CFR 1.77 (arrangement and contents of the specification) and 37 CFR 1.78(a)(1)(iv)(i) (cross-reference to related applications), and reflect the arrangement and contents of the specification of the parent application, 09/700,094. Applicants' preliminary amendment filed 27 January 2004 included a cross-reference to the parent application, serial number 09/700,094, but that application had not yet issued as a patent. The cross-reference to the parent application is re-stated hereinbelow, with added reference to the patent number of the parent application.

IN THE SPECIFICATION –

At page 1, under the title of the application, insert the following paragraph:

"The present application is a Continuation Application of USSN 09/700,094, filed January 2, 2001, now US Patent 6,713,464, which in turn claimed the priority benefit of PCT/EP99/03212, filed May 11, 1999."

Followed by the heading:

--BACKGROUND OF THE INVENTION--

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At page 3, line 17 (before the paragraph that begins "It is an object...") insert the heading:

--SUMMARY OF THE INVENTION--

At page 4, starting at line 4 (BEFORE the paragraph beginning that begins "According to the present invention..." insert the following paragraph and headings:

--BRIEF DESCRIPTION OF THE DRAWING

FIG. 1 shows the formation of the active metabolite from different prodrugs by human liver S 9(%) in 1 hour.

DETAILED DESCRIPTION OF THE INVENTION--

end of amendments

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 C.F.R. 1.17(e), was filed in this application after allowance. Since this application is eligible for continued examination under 37 C.F.R.1.114, and the fee set forth in 37 C.F.R. 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 C.F.R. 1.114. Applicant's submission filed on 23 August 2005 has been entered and considered by the examiner, and forms PTO-1449 initialed and signed by the examiner, to that effect are enclosed herewith.

Allowable Subject Matter

Claims 50-63 are allowed.

The reasons for indication of allowable subject matter remain the same as were explained in the Notice of Allowability mailed 10 May 2005, and can be found in that Office action.

The submission of the Information Disclosure Statement of 23 August 2005, with the Requested for Continued Examination under 37 C.F.R. 1.114 has been considered and none of the cited references are novelty-destroying or render obvious the claimed compounds, methods and compositions.

Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

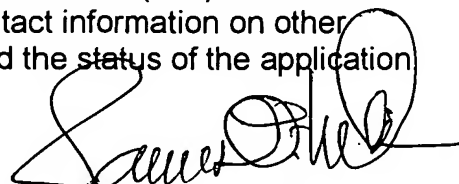
Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312;

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information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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A handwritten signature in black ink, appearing to be "zt" followed by a stylized flourish.A handwritten signature in black ink, appearing to be "James O. Wilson".

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600